



DEPARTMENT OF COMMERCE

Patent and Trademark Office

[Docket No.: PTO-P-2021-0039]

Climate Change Mitigation Pilot Program

AGENCY: United States Patent and Trademark Office, Department of Commerce.

ACTION: Notice.

SUMMARY: As part of its ongoing efforts to incentivize more and inclusive innovation, including in key technology areas such as climate change, and to maximize that innovation's widespread impact, including by reducing greenhouse gas emissions, the United States Patent and Trademark Office (USPTO) is implementing the Climate Change Mitigation Pilot Program, which is designed to positively impact the climate by accelerating the examination of patent applications for innovations that reduce greenhouse gas emissions. The program is intended to encourage research, development and innovation in the climate space and provide ready and equitable intellectual property protection to incentivize investment and bring those solutions to the country and world. The program aligns with and supports Executive Order 14008, dated January 27, 2021, and is part of the USPTO's efforts to secure an equitable economic future, reduce greenhouse gas emissions and mitigate climate change. Applications accepted into the pilot program will be advanced out of turn (accorded special status) for first action on the merits.

DATES: *Pilot Duration:* The Climate Change Mitigation Pilot Program will accept petitions to make special beginning [INSERT DATE OF PUBLICATION IN THE FEDERAL REGISTER] until either [INSERT DATE TWELVE MONTHS AFTER DATE OF PUBLICATION IN THE FEDERAL REGISTER] or the date the USPTO

accepts a total of 1,000 grantable petitions, whichever occurs first. The USPTO may, at its sole discretion, terminate the pilot program depending on factors such as workload and resources needed to administer the program, feedback from the public, and the effectiveness of the program. If the pilot program is terminated, the USPTO will notify the public. The USPTO will indicate on its website the total number of petitions filed and the number of applications accepted into the pilot program.

FOR FURTHER INFORMATION CONTACT: Kristie M. Kindred, Legal Advisor, Office of Patent Legal Administration, Office of the Deputy Commissioner for Patents, at *Kristie.Kindred@uspto.gov*; or Susy Tsang-Foster, Senior Legal Advisor, Office of Patent Legal Administration, Office of the Deputy Commissioner for Patents, at *Susy.Tsang-Foster@uspto.gov*. For questions on electronic filing, please contact the Electronic Business Center at: 866-217-9197 during their operating hours of 6 a.m. to midnight ET, Monday - Friday, or email at *ebc@uspto.gov*. For questions relating to a particular petition, please contact the Office of Petitions at 571-272-3282 during their operating hours of 8:30 a.m. to 5 p.m. ET, Monday – Friday.

SUPPLEMENTARY INFORMATION: New patent applications are normally taken up for examination in the order of their U.S. filing date or national stage entry date. *See* §§ 708 and 1893.03(b) of the Manual of Patent Examining Procedure (MPEP) (9th ed., rev. 10.2019, June 2020). The USPTO has procedures under which an application will be advanced out of turn (accorded special status) for examination if the applicant files (1) a petition to make special under 37 CFR 1.102(c) or (d) with the appropriate showing, or (2) a request for prioritized examination under 37 CFR 1.102(e). *See* 37 CFR 1.102(c)-(e) and MPEP §§ 708.02, 708.02(a), and 708.02(b). The USPTO revised its accelerated examination procedures effective August 25, 2006, requiring that all petitions to make special comply with the requirements of the revised accelerated examination (AE) program set forth in MPEP § 708.02(a), except those based on an inventor's health or age

or the Patent Prosecution Highway (PPH) Pilot Program. *See Changes to Practice for Petitions in Patent Applications To Make Special and for Accelerated Examination*, 71 FR 36323 (June 26, 2006).

The USPTO is implementing a new Climate Change Mitigation Pilot Program. The program, which aligns with and supports Executive Order 14008, permits an application that claims certain products and/or processes that mitigate climate change by reducing greenhouse gas emissions to be advanced out of turn (accorded special status) for first action on the merits without meeting all of the requirements of the accelerated examination program set forth in MPEP § 708.02(a) (for example, examination support document) if the applicant files a petition to make special under 37 CFR 1.102(d) meeting all of the requirements set forth in this notice.

To qualify, applicants must file a petition to make special under the pilot program, and the application must claim an invention directed to certain technologies that are designed to reduce greenhouse gas emissions. Applicants must also certify that (1) they have a good faith belief that expediting examination of the application will likely have a positive impact on the climate, and (2) the inventor or any joint inventor has not been named as the inventor or a joint inventor on more than four other nonprovisional applications in which a petition to make special under this program has been filed. Applications accepted into the pilot program will be advanced out of turn (accorded special status) for first action on the merits without meeting all of the current requirements, including any extra fee payments, of the accelerated examination program (for example, the requirement for an examination support document) or the prioritized examination program (for example, the prioritized examination fee or processing fee).

All other requirements of the accelerated examination program that are not required by this notice, including the 37 CFR 1.17(h) fee for a petition to make special under 37 CFR 1.102(d), are hereby waived based upon the special procedure specified in this notice.

The USPTO will periodically evaluate the pilot program to determine whether and to what extent its coverage should be expanded or limited.

No fees or requirements other than those discussed above are waived by this pilot program.

Part I. Requirements to Participate

In addition to filing a nonprovisional patent application that is ready for examination (including a specification, drawing(s) if necessary, at least one claim, and payment of all fees associated with the filing of an application), the patent application and the petition to participate in this pilot program must meet the requirements that follow.

(1) Types of Applications and Time for Filing Petition

The petition to make special under the pilot program must be filed:

a) with the electronic filing of a noncontinuing original utility nonprovisional application or entry into the national stage under 35 U.S.C. 371, or within 30 days of the filing date or entry date of the application; or

b) with the electronic filing of an original utility nonprovisional application claiming the benefit of an earlier filing date under 35 U.S.C. 120, 121, 365(c), or 386(c) of only one prior nonprovisional application or only one prior international application designating the United States or within 30 days of the filing date of such application.

Definition

Noncontinuing application: A noncontinuing application is an application that is not a continuation, divisional, or continuation-in-part application filed under the conditions specified in 35 U.S.C. 120, 121, 365(c), or 386(c) and 37 CFR 1.78. *See* section 201.02 of the MPEP.

The pilot program is reserved for the nonprovisional applications described above that have not received a first office action (including a written restriction requirement). Any

application that claims the benefit of the filing date of two or more prior filed applications that are nonprovisional U.S. applications and/or international applications designating the United States is not eligible for participation in the pilot program. Claiming the benefit under 35 U.S.C. 119(e) of one or more prior provisional applications or claiming a right of foreign priority under 35 U.S.C. 119(a)-(d) or (f) to one or more foreign applications will not affect eligibility for the pilot program.

(2) Office Form Required for Filing Petition

Form PTO/SB/457, titled “CERTIFICATION AND PETITION TO MAKE SPECIAL UNDER THE CLIMATE CHANGE MITIGATION PILOT PROGRAM,” is required to be used to make the petition under the pilot. It is available at <https://www.uspto.gov/patent/forms/forms-patent-applications-filed-or-after-september-16-2012>. Form PTO/SB/457 contains the necessary certifications for qualification to participate in the pilot. Use of the form will enable the USPTO to quickly identify and timely process the petition. In addition, use of the form will help applicants understand and comply with the petition requirements of the pilot program. Under 5 CFR 1320.3(h), form PTO/SB/457 does not collect “information” within the meaning of the Paperwork Reduction Act of 1995.

(3) Required Certification

The petition to make special must certify: (1) that the claimed invention covers a product or process that mitigates climate change; (2) that the product or process is designed to reduce greenhouse gas emissions; (3) that applicant has a good faith belief that expediting patent examination of the application will likely have a positive impact on the climate; and (4) that the inventor or any joint inventor has not been named as the inventor or a joint inventor on more than four other nonprovisional applications in which a petition to

make special under this program has been filed. Form PTO/SB/457 contains these certifications.

(4) Publication Requirement for Applications

If applicant files the petition to make special on the date of filing of an application, the application may not be filed with a nonpublication request. If applicant previously filed a nonpublication request in the application, applicant must file a rescission of the nonpublication request no later than the time the petition to make special is filed. Applicant may use form PTO/SB/36 to rescind the nonpublication request.

(5) Application Data Sheet Requirement

Unless previously filed in the patent application, the petition must be accompanied by a properly signed application data sheet per 37 CFR 1.76 meeting the conditions specified in 37 CFR 1.53(f)(3)(i).

(6) Claim Limit and No Multiple Dependent Claims

When the petition is filed and throughout pendency, the application must contain no more than 3 independent claims and 20 total claims and no multiple dependent claims. The examiner may refuse entry of any amendment filed in reply to an office action that, if entered, would result in a set of pending claims that exceeds either of these claim limits or adds a multiple dependent claim. See Part IV of this notice.

(7) Electronic Filing of Application and Petition Required

The petition to make special may only be made by filing form PTO/SB/457, which must be filed electronically using the USPTO's Patent Center (at <https://patentcenter.uspto.gov/#!/>). Applicants must file the petition using the document

description indicated on form PTO/SB/457. In addition, the application or national stage entry must be filed using Patent Center, and the specification, claims, and abstract must be submitted in DOCX format. Prior to submitting the application for filing, applicants will receive a feedback document. Applicants may find it beneficial to review the feedback document and make corrections to the application before filing the application. By making the necessary corrections before filing, applicants may avoid delays that can occur in the pre-examination process. For more information on DOCX filing in Patent Center, please see <https://www.uspto.gov/patents/docx>.

(8) Filing Limitations

An applicant may file a petition to participate in the pilot program if the inventor or any joint inventor has not been named as the inventor or a joint inventor on more than four other nonprovisional patent applications in which a petition to make special under this program has been filed. Therefore, if the inventor or any one of the joint inventors of the instant application has been named as the inventor or a joint inventor on more than four other nonprovisional applications in which petitions under this pilot program have been filed, then the petition for the instant application may not be appropriately filed.

Definition

Claimed invention covers a product or process that mitigates climate change: This phrase is only met when an application includes a claim that would correspond to one or more of the technical concepts within subclass Y02A, Y02B, Y02C, Y02D, Y02E, Y02P, Y02T or Y02W in the Cooperative Patent Classification (CPC) system. For example, a claim to a process to capture or dispose of methane would correspond to Y02C 20/20. The full schedule of Y02 class is available at:

<https://www.uspto.gov/web/patents/classification/cpc/html/cpc-Y.html#Y02>.

Part II. Internal Processing of the Petition under the Pilot Program

If applicant files a petition to make special under the pilot program, the USPTO will decide the petition once the application is in condition for examination. If the petition is granted, the application will be accorded special status under the pilot program. The application will be placed on an examiner's special docket until a first office action on the merits. After the first action on the merits, the application will no longer be treated as special during examination, for example, if an amendment is filed, it will be placed on the examiner's regular amended docket.

If the petition to make special under the pilot program does not comply with the requirements set forth in this notice, the USPTO may notify the applicant of the deficiency by issuing a notice. The notice will give applicant only *one opportunity* to correct the deficiency. If applicant still wishes to participate in the pilot program, applicant must file a reply via Patent Center that includes appropriate corrections and a properly signed petition form PTO/SB/457 within one month or thirty days, whichever is longer, from the mailing/notification date of the notice informing applicant of the deficiency. The time period for reply is *not* extendable under 37 CFR 1.136(a). If applicant fails to correct the deficiency indicated in the notice within the time period set forth therein, the application will not be accepted into the pilot program and will be taken up for examination in accordance with standard examination procedures. In addition, the petition will be dismissed without an opportunity for correction if it is deficient in any of the following ways: 1) The application does not contain a claim that complies with the eligibility requirements of this notice (that is, the claim does not cover a product or process that mitigates climate change by reducing greenhouse gas emissions); 2) The

application claims the benefit of the filing date of two or more prior filed applications that are nonprovisional U.S. applications and/or international applications designating the United States; and 3) The petition was not filed with the application or entry into the national stage under 35 U.S.C. 371 or within 30 days of the application's filing date or national stage entry date.

Part III. Requirement for Restriction

If the claims in the application are directed to multiple inventions, the examiner may make a requirement for restriction or unity of invention in accordance with current restriction practice. The examiner will attempt to contact the applicant following the procedure for the telephone restriction practice set forth in MPEP § 812.01. If a telephone restriction requirement is made, applicant must make an election without traverse to an invention that meets the eligibility requirements of this notice. If applicant refuses to make an election (for example, by failing to reply to a request for a telephonic interview within five business days of the examiner's request), the special status of the application will be terminated and the examiner may mail a written restriction requirement.

Part IV. Office Actions and Replies under the Pilot Program

Applications that are accorded special status under the pilot program will be placed on an examiner's special docket until a first office action on the merits.

After the first office action on the merits, the application will be placed on the examiner's regular docket.

A reply to an office action must be fully responsive to the rejections, objections, and requirements made by the examiner. Any amendment filed in reply to an office action may be treated as not fully responsive if it attempts to: (1) add claims that would result in more than three independent claims or more than 20 total claims pending in the application; (2) add any multiple dependent claim(s); or (3) cancel all claims that meet the requirements of the pilot program (that is, the application no longer contains any claims that cover a product or process that reduces greenhouse gas emissions and thereby mitigate climate change). If a reply to a nonfinal office action is not fully responsive because it does not comply with the pilot claim requirements but is a *bona fide* attempt to advance the application to final action, the examiner may, at their discretion, provide a shortened statutory period of two (2) months for the applicant to supply a fully responsive reply. Extensions of this time period under 37 CFR 1.136(a) to the notice of nonresponsive amendment will be permitted, but in no case can any extension carry the date for reply to this notice beyond the maximum period of SIX MONTHS set by statute (35 U.S.C. 133). However, any further nonresponsive amendment typically will not be treated as *bona fide*, and therefore, the time period set in the prior notice will continue to run.

Part V. After-Final and Appeal Procedures

Any amendment, affidavit, or other evidence after a final office action and prior to appeal must comply with 37 CFR 1.116. During the appeal process, the application will be treated in accordance with the normal appeal procedure (see MPEP Chapter 1200).

Part VI. Proceedings Outside the Normal Examination Process

If an application becomes involved in proceedings outside the normal examination process (for example, a secrecy order, derivation proceeding, or petitions under 37 CFR 1.181-1.183), the USPTO will place the application in special status under the pilot program before and after such proceedings. During those proceedings, however, the application will not be under special status. For example, while under a secrecy order, the application will be treated in accordance with the normal secrecy order procedures and will not be in special status under the pilot program. Once the proceeding outside the normal examination process is completed, the application will continue in special status as described above in this notice.

Part VII. Withdrawal from the Pilot Program

There is no provision for withdrawal from the pilot program. An applicant may abandon an application that has been granted special status under the pilot program in favor of a continuing application. However, a continuing application will not automatically be granted special status based on the petition filed in the parent application. Each application (including each continuing application) must, on its own, meet all requirements for special status under the pilot program, and be accompanied by its own petition as detailed in Part I (2) above.

Katherine K. Vidal,

Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office.

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